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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/150,692	09/10/98	BACHAND G	5137

IM22/0912

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EXAMINER	
BECKER, D	
ART UNIT	**PAPER NUMBER**
1761	11

DATE MAILED: 09/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/150,692	Applicant(s) Bachand et al
	Examiner Drew Becker	Group Art Unit 1761

☒ Responsive to communication(s) filed on *Aug 28, 2000*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-20* is/are pending in the application.

Of the above, claim(s) *11-13* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-10 and 14-20* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. This application contains claims 11-13 drawn to an invention nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-10 and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "temporarily" in claim 14 is a relative term which render the claims indefinite. The term "temporarily" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear how long a period of time is defined by "temporarily".

5. The term "unintentional" in claim 14 is a relative term which render the claims indefinite. The term "unintentional" is not defined by the claims, the specification does not provide a

standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear what type of action would be classified as "unintentional".

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is indefinite because of the use of the term "substantially" therein. Cancellation of said term will overcome the rejection. *Ex parte Sussman*, 8 USPQ2d 1443 (Bd. Pat. App. & Inter. 1988), *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992) and 37 CFR 1.153. It is not clear what length is "substantially shorter than the elongated length". (0.5%? 65%? 99.9%?)

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claim 14 is rejected under 35 U.S.C. 102(a) as being anticipated by WO 97/33822. WO 97/33822 teach a rolled food item comprising a strip of food material (page 6, line 35), a paper strip (page 7, line 11), rolling the strips together (page 9, line 1), and the food strip having

an area at the trailing edge with a greater moisture content, provided by an edible adhesive, which holds the roll together during packaging (page 16, line 5).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/33822.

WO 97/33822 teach a rolled food item and a method of making a rolled food item comprising a strip of food material (page 6, line 35), a paper strip (page 7, line 11), rolling the strips together (page 9, line 1), and the food strip having an area at the trailing edge with a greater moisture content, provided by an edible adhesive, which holds the roll together during packaging (page 16, line 5). It would have been obvious to one of ordinary skill in the art to spray the edible adhesive of WO 97/33822 onto the food strip since spraying the edible adhesive would produce a greater area of surface coverage for the edible adhesive thereby creating a stronger bond which would resist unrolling better than a single drop. It would have been obvious to one of ordinary skill in the art to use water free of adhesives with the invention of WO 97/33822 since WO 97/33822 teach the use of an edible adhesive, of which water is a type as evidenced by Cherukuri et al [Pat.

No. 4,352,825] which teach the additional tackiness and stickiness of confections when an increased moisture content is present (column 1, line 23).

11. Claims 5-10 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/33822 as applied to claims 1-3 and 14 above, in view of Zoss [Pat. No. 5,853,836]. WO 97/33822 teach the above mentioned concepts, the food material being dehydrated fruit material (page 7, line 11), and the food strip being cut to the same length as the paper (page 8, line 23). WO 97/33822 do not teach the paper being silicon parchment paper and the paper being wider than the food strip. Zoss teaches a rolled food product and a method of making a rolled food product comprising the use of silicon parchment paper (column 3, line 53) and the paper being wider than the food strip (column 3, lines 57-62). It would have been obvious to one of ordinary skill in the art to incorporate the paper structure of Zoss into the invention of WO 97/33822 since Zoss teaches that silicon parchment paper is strong enough to resist tearing without being bulky (column 3, line 55) and since having the paper be wider than the food strip prevents the food strip from rubbing against fabrication equipment (column 3, line 63 to column 4, line 3).

Response to Arguments

12. Applicant's arguments filed August 28, 2000 have been fully considered but they are not persuasive.

Applicant argues that the restriction is improper and should be withdrawn. This argument was made in the previous response from the applicant and was deemed proper and therefore FINAL in paper no. 8. As noted in paragraph no. 1 above, claims 11-13 should be cancelled in applicant's next response.

Applicant argues that the edible adhesive of WO 97/33822 is not sprayed and does not increase the tackiness of the food. It would have been obvious to one of ordinary skill in the art to spray the edible adhesive of WO 97/33822 onto the food strip since spraying the edible adhesive would produce a greater area of surface coverage for the edible adhesive thereby creating a stronger bond which would resist unrolling better than a single drop. With regard to the tackiness of the food, this would be an inherent property of water or moisture. WO 97/33822 teach the use of edible adhesives (page 16, line 5). Water is known to tackify confections and cause them to become sticky, as shown by Cherukuri (column 1, line 23), and also is an edible material. Therefore, water would fall under the general category of "edible adhesive" used by WO 97/33822. Regardless, even an adhesive such as corn syrup would inherently possess a certain amount of water.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that Cherukuri does not disclose spraying water or using water as an adhesive in a rolled food. In the rejection,

Cherukuri is merely relied upon to show that it was known that water tackifies confections. Cherukuri is not relied upon to teach spraying.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). WO 97/33822 and Zoss are both directed to the production of rolled confectionary foods while Cherukuri shows that water is a known edible adhesive when applied to confectionary material.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 19880; *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, WO 97/33822 and Zoss are both directed to the production of rolled confectionary foods while Cherukuri shows that water is a known edible adhesive when applied to confectionary material.

It should be noted that while applicant directs most of the arguments toward the Cherukuri reference, this is not the main reference relied upon and in fact is used merely as an evidentiary reference in support of WO 97/33822. Cherukuri is merely used to show that water was known to cause confections to become sticky when applied in excessive amounts (column 1, line 23).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew Becker whose telephone number is (703)-305-0300. The examiner can normally be reached on Monday-Thursday from 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached on (703)-308-0756. The fax number for this Group is (703)-305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Drew Becker

September 7, 2000

KEITH HENDRICKS
PRIMARY EXAMINER